

DETAILED ACTION

1. This action is responsive the amendment along with the RCE filed on 11/13/2009. Claims 13, 17, 20-25, and 27-33 are pending. Claim 27 is independent. Claims 27-33 are newly added. Claims 1-12, 14-16, 18, 19, and 26 are cancelled. Claims 17, 20-22, 24, 29, 31, and 32 are withdrawn from consideration.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/2009 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13, 23, 25, 27, 28, 30, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Rutkow et al (US Pat. No.: 5,356,432).

In regard to Claims 13, 25, 27, 28, 30, and 33, Rutkow et al discloses an implantable prosthesis, comprising a flexible plug (12) of surgically compatible mesh material, the plug have an elongate form and comprising an external mesh material wall

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(Fig. 2); wherein the external material wall has three projecting longitudinal ridges or bulges which provide the plug with a generally triangular cross-sectional shape (see Figure below); and the plug further comprising an internal support webs (14 or 28) extending into contact with respective interiors of the projecting longitudinal ridges or bulges; wherein the webs are formed by separate parts bonded to an inner surface of the external mesh material wall (Fig. 3); wherein the mesh material includes at least one joint (Fig. 3, the mesh material has at least one joint); wherein the plug has a prismatic shape (Fig. 3, the plug is shaped similar to a cone. Also, part 18 of the plug 12 has a prismatic shape); and wherein the mesh material comprises polypropylene (Col. 4, line 9).

In regard to Claim 23, the claimed phrase “wherein the plug is cut to an appropriate required dimension from a stock length piece” is being treated as a product by process limitation; that is . As set forth in MPEP 2113, product by process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. MPEP 2113.

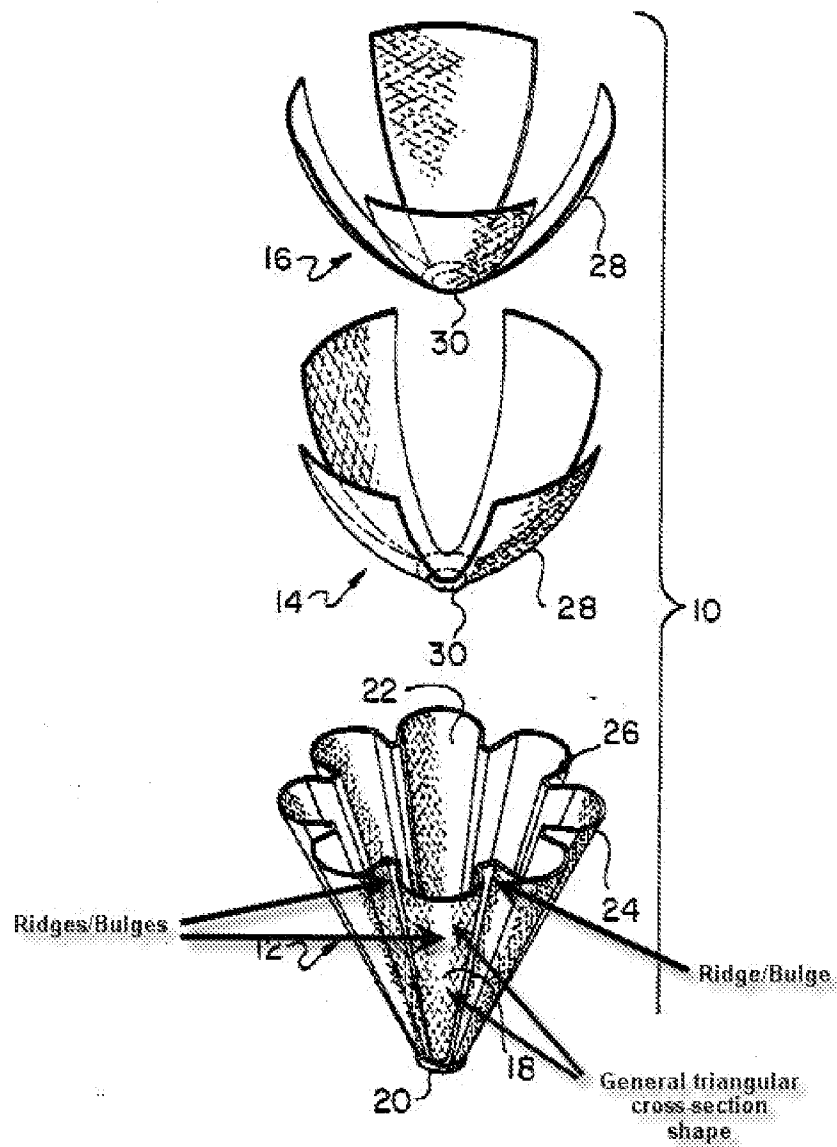


Fig.2

Response to Arguments

5. Applicant's arguments filed 11/13/2009 have been fully considered but they are not persuasive. The allegation on page 5 of the remarks that the internal support of Rutkow's device does not extend into contact with respective interiors of the projecting longitudinal ridges or bulges is incorrect. The internal support 14 or 28 of Rutkow's device clearly extends into contact with respective interiors of the projecting longitudinal ridges or bulges (Fig. 3). In addition, the internal support 14 or 28 is capable to maintain the shape of the external mesh material wall from external force to a certain extend. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING OU whose telephone number is (571)270-5036. The examiner can normally be reached on M-F 7:30am - 5:00pm, Alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen (Jackie) T Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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